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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,950	03/10/2004	Richard Emil Kajander	7338	4492

7590 10/11/2006

JOHNS MANVILLE
Legal Department
10100 West Ute Avenue
Littleton, CO 80127

EXAMINER

GRAY, JILL M .

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,950

Applicant(s)

KAJANDER

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-15,21-25,28,31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20,26,27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/29/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II and claims 26-27 in the reply filed on July 7, 2006 is acknowledged. The traversal is on the ground(s) that the examiner has not shown that Groups I and II are distinct or operate in a materially different way, and that it is merely conclusory by the examiner that the product claimed in either Group I or Group II could be made by another materially different method, and that the species alleged by the examiner are not all mutually exclusive. This is not found persuasive because the structural component of a mat in Group II is distinct from the glass fibers per se of Group I. Also, the process of claim 31 makes a materially different product than that of Group II, and the process of claim 32 makes a materially different product than that of Group I. As to the product of Group II, this can be made by a materially different process such as precoating the mat with dry mix, hydrating, and adding to layer on first facer. Regarding the species being mutually exclusive, the examiner is unpersuaded.

The requirement is still deemed proper and is therefore made FINAL.

Claims 16-20, 26-27 and 29-30 are currently under prosecution. Claims 1-15, 21-25, 28, and 31-32 are drawn to non-elected subject matter.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16-20, 26-27, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Take et al, 4,645,548 (Take) in view of Dierks et al, 4,195,110 (Dierks) and Kuroda et al, 4,741,773 (Kuroda).

Take teaches gypsum board comprising a gypsum matrix having a top and bottom, wherein the gypsum matrix is of the type contemplated by applicants in claims 18 and 19, wherein the matrix has a first facer sheet placed on the bottom and a second facer sheet placed on the top, said facer sheets being paper, per claim 17, further teaching that glass fibers can be added, but does not specifically teach that the glass fibers are a glass fiber mat coated with silane. See abstract, column 2, lines 13-47, column 4, lines 62-63 and column 5, lines 28-40. Dierks teaches glass reinforced composite gypsum board wherein the glass fibers can be in the form of a mat. See column 3, lines 25-31. Accordingly, the inclusion of glass fibers in the form of a mat is known in this art as evidenced by the teachings of Dierks. To modify the teachings of Take by using a glass fiber mat would have been an obvious variant to the skilled artisan at the time the invention was made. Dierks does not teach coating his fibers with silane. Kuroda teaches a water repellent solution comprising polydimethylsiloxane, per claims 20, 26, 27, and 29, wherein said composition can be applied to glass fiber mat and coated onto gypsum board. See column 1, lines 4-10, and 45-60, column 4, lines 18-31, Examples 1-5 and 14-16. It would have been obvious at the time the invention was made to coat the glass fibers of Take with a silane of the type contemplated by applicants, motivated by the ability to obtain a gypsum board having

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water repellent properties. As to claim 30, this claim is drawn to the thickness of the size composition. This limitation is not construed to be critical in the absence of factual evidence to the contrary.

Therefore, the combined teachings of Take, Dierks, and Kuroda would have rendered obvious the invention as claimed in present claims 16-20, 26-27, and 29-30.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 16-20, 26-27, and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-25, 28, 39-40, and 42 of copending Application No. 10/913,768. Although the conflicting claims are not identical, they are not patentably distinct from each other because the gypsum matrix is substantially the same, and thus the matrix of the present invention is inherently acidic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 16-20, 26-27, and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7-10 of copending Application No. 10/796,951. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been an obvious to include particles as filler material in the composition of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claims are allowed.

Conclusion

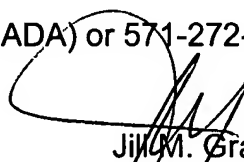
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jill M. Gray
Primary Examiner
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jmg